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MARKOFF, ALEXANDER	
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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Application Number: 10/026,239

Filing Date: 12/21/01

Appellant(s): Humenik et al

Ira D. Blecker

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/24/05 appealing from the Office action mailed 05/27/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1-16.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Sachdev et al US Patent No 6,277,799

Sachdev et al US Patent No 6,280,527

Spring, Metal Cleaning, pages 67-73 (1963)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,280,527 in view of Spring (Metal Cleaning).

The claims US Patent No 6,280,527 disclose cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures.

The Patent does not teach electrolytic cleaning or two-step process wherein the electrolytic cleaning follows the non-electrolytic cleaning.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68. Spring teaches that electrocleaning enhance the chemical cleaning in several ways.

Spring recommends electrolytic cleaning where high quality metal cleaning is needed. See page 67.

Spring also teaches that during electrolytic cleaning upon passage of current water in cleaning solution is electrolyzed to hydrogen and oxygen gasses. The generation of gasses provides a high level of agitation. In addition Spring teaches that the electrical charge imposed on the work is important in removing complex soils. See page 67.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes. See page 68.

Further, Spring teaches that it was conventional in the art to clean articles non-electrolytic with the same electrolyte (same cleaning solution) to provide sufficient removal of soil and to enhance forming of gas bubbles during electrolytic cleaning. See page 68.

It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patent to enhance the cleaning, to provide high quality metal cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes, was conventional for cleaning metal articles with complex from complex soils to high quality and because the method of the Patent is directed to cleaning of metal articles with complex soils in the application where high quality of cleaning is required.

Claim Rejections - 35 USC § 103

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over any one U.S. Patent No. 6,280,527 and 6,277,799 in view of Spring (Metal Cleaning).

The applied references have a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

US Patents No 6,280,527 and 6,277,799 teach cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures. See entire documents, especially column 1, lines 6-50, column 4, line 12 – column 7, line 42, Examples 1 and 2 of 6,280,527 and column 1, lines 4-28, column 4, line 22 – column 5, line 60 and Examples 1 and 2 of 6,277,799.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68. Spring teaches that electrocleaning enhance the chemical cleaning in several ways.

Spring recommends electrolytic cleaning where high quality metal cleaning is needed. See page 67.

Spring also teaches that during electrolytic cleaning upon passage of current water in cleaning solution is electrolyzed to hydrogen and oxygen gasses. The generation of gasses provides a high level of agitation. In addition Spring teaches that the electrical charge imposed on the work is important in removing complex soils. See page 67.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes. See page 68.

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It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patent to enhance the cleaning, to provide high quality metal cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes, was conventional for cleaning metal articles with complex from complex soils to high quality and because the method of the Patent is directed to cleaning of metal articles with complex soils in the application where high quality of cleaning is required.

(10) Response to Argument

1. With respect to Double patenting rejection the Appellants argue that their review indicates that the obviousness-type double patenting rejections are typically made only in the situations where there has been a period of copendency between either two applications or an application and a patent.

The Appellants also state that according to their position the obviousness-type double patenting rejection should not be extended to those situations where the underlying patent is statutory art other than through 35 USC 102(e).

These arguments are based on the Appellant's own statements.

No requirement for copendency for making the obviousness-type double patenting rejections is presented in MPEP, cited authorities, other authorities, 37 CFR, or 35 USC. In contrast. MPEP 804 in contrast to the Appellant's statements requires to make the double patenting rejection when the conflicting claims are presented in the application and a patent, which are commonly owned and have different inventive entities. It means that the obviousness-type double patenting rejection based on the patent filed prior to the filing date of the application is proper and should be made.

It is also noted that timewise for the purposes of double patenting analysis and 35 USC 103 analysis US Patent 6,280,527 is qualified not only as 35 USC 102(a) document, but also as 35 USC 102(e) document because no showing of common ownership at the time of the invention was provided. This also makes the Appellants arguments not persuasive.

2. With respect to rejection made under 35 USC 103(a) the Appellants argue that according to their position there is no motivation to combine the patents issued to Sachdev et al with Spring.

This is not persuasive because Spring recommends electrolytic cleaning where high quality metal cleaning is needed. Spring also teaches that during electrolytic cleaning upon passage of current water in cleaning solution is electrolyzed to hydrogen and oxygen gasses. The generation of gasses provides a high level of agitation. In addition Spring teaches that the electrical charge imposed on the work is important in removing complex soils. Further, Spring teaches that electrolytic cleaning reduces release of fumes.

Thus Spring provides motivation to combine the teachings.

It is noted that the Appellants state that "fuming is not actually issue here". This statement is not supported. The examiner's position that fuming is an issue where the spay of alkaline solution is used. Spring is specifically addresses such issue and emphasizes the health hazard for personnel. See at least first full paragraph on page 69.

The examiner's position is that in contrast to the Appellant's statement reducing the health hazard is a proper motivation to combine the teaching of the documents.

It is noted that the Appellants state that the claimed method provides unexpected results.

This statement is not persuasive because Spring teaches that electrolytic cleaning enhances chemical cleaning in several ways. Spring also teaches that

electrolytic cleaning is especially beneficial for removing complex soils from metals works. Spring further teaches that electric charge itself is important in removing complex soils. An ordinary artisan would have reasonably expected that electrocleaning would significantly enhance the cleaning results on the method Sachdev et al, which deals with removing of complex residues from the metal works. The improvement achieved by the claimed method could not be considered unexpected.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Alexander Markoff

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